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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/417,266 10/12/99 MAROFIS

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WILLIAM A WEBB
BRINKS HOFER GILSON & LIONE
P O BOX 10395
CHICAGO IL 60610

WM02/0104

EXAMINER

FOSTER, R

ART UNIT

PAPER NUMBER

2645

DATE MAILED:

01/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/417,266

Applicant(s)

MAROPIS ET AL.

Examiner

Roland G. Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 15 recites that a subscriber account is created. However, independent claim 14 from which claim 15 depends upon also recites that a subscriber account is established. It is not clear how a particular subscriber account is created two times. The specification also does not appear to disclose creating two accounts for a particular subscriber. In the interests of compact Office prosecution, claim 15 will be interpreted in this Office action as though the Applicant's intent was to "identify" the subscriber account similar to the limitations set forth in claim 1. If the Applicant's intent was to claim that two subscriber accounts for a particular subscriber were indeed created, then there appears to be a lack of enablement in the specification and a rejection under 35 USC § 112, first paragraph would be appropriate.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 8-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Taskett (U.S. Patent No. 5,762,376).

With respect to claim 8, the following limitations read upon Taskett.

“a prepaid local telephone call service center in communication with the at least one local exchange carrier...” reads on Fig. 6, Service Provider (608) (prepaid local telephone call service center) and LEC (620) (local exchange carrier). See also col. 1, lines 20-24.

“an applications server having a processor and a subscriber database” reads on col. 7, lines 23-25. “...the subscriber database comprising subscriber service period information and subscriber identification information” reads on col. 8, lines 3-23. “...the applications server further comprising means for automatically communicating service termination date information to a subscriber prior to an expiration of a service period for

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the subscriber" reads on Fig. 4, Telephone Card Insert (101), line 10 and col. 3, lines 45-48. Fig. 4 illustrates that Card (101) communicates "service termination date information to a subscriber prior to an expiration of a service period for the subscriber" in the form of an "expiration date" at line 10. Since the printed Card (101) contains account information from the Service Provider (608) (applications server) (col. 6, lines 20-25), the applications server can be said to "automatically" communicate the date to the subscriber via the ATM or POS printout.

Claim 14 substantively differs from claim 8 in that claim 14 recites a method equivalent to the functions performed by the call service center recited in the claim 8 rejection. Therefore see the claim 8 rejection for further details.

Claim 16 substantively differs from claim 14 in the claim 16 recites that "a reminder message" is sent to the subscriber prior to expiration. However, printing out a card with an expiration date message to the subscriber is equivalent to sending a reminder message prior to expiration. Claim 16 also recites sending a "suspend message" comprising "an instruction to suspend local telephone service for the subscriber" reads on the service "terminating" the call (col. 8, lines 38-40) which inherently requires disconnecting the caller (suspending local telephone service). The service can be restarted if the caller makes other arrangements for payment (col. 8, lines 35-40). Therefore, the service can be said to be temporarily "suspended". Since the caller is no longer able to place long distance calls because the account is fully

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withdrawn, the account can be said to be "inactive" (no funds withdrawn for long distance calls).

With respect to claims 9 and 11, Taskett discloses that the Service Provider (608) can "terminate the call" upon expiration of the service due to account depletion (col. 8, lines 33-40) which would inherently require communicating a message to LEC (620) (local exchange carrier) from Service Provider (608) (applications server) in order to cause the LEC (620) to terminate or "disconnect" the connection to the subscriber.

With respect to claim 10, since Taskett discloses that the service may be continued upon an "other arrangements for payment" (col. 8, lines 35-40), the renewal invitation may be said to be a "hold order" pending arrangement for other payments.

With respect to claim 12, a "grace period timer" would inherently be required in order to determine that the caller had accepted or declined the invitation to make other arrangements (col. 8, lines 35-40). Otherwise the caller would be able to indefinitely extend the grace period by simply not responding to the invitation.

With respect to claim 13, "automatically communicating a message to the local exchange carrier upon an expiration of the grace period" reads upon col. 8, lines 35-40 where the call is terminated which would inherently require the Local Exchange Carrier (local telephone company) to receive a message to disconnect to caller.

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With respect to claim 15, as it can best be understood, the following limitations read upon Taskett.

"receiving a telephone call from the subscriber" reads on col. 8, lines 3-7.

"identifying a subscriber account in a prepaid local telephone call database for the subscriber" reads on col. 8, lines 7-19.

"receiving a value identification code associated with the prepaid local telephone service program" reads on col. 8, lines 19-20 where the current available balance (value identification code) is received from the account. The balance is a "code" that determines the amount of time available.

"determining a period of service for the identified subscriber account" reads on col. 8, lines 20-23.

"monitoring the period of service at the prepaid local telephone call database" reads on col. 8, lines 24-37.

"sending termination data information to the subscriber prior to an expiration of the period of service" reads on Fig. 4, Telephone Card Insert (101), line 10 and col. 3, lines 45-48 as discussed in the claim 8 rejection above.

Claims 1 and 3-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Cohen et al. (U.S. Patent No. 5,946,380) [Hereinafter Cohen].

With respect to claim 1, the following limitations read upon Cohen.

"...prepaid local telephone services..." reads on the abstract.

"receiving a telephone call from the subscriber" and "identifying a subscriber account in a prepaid local telephone call database for the subscriber based on the telephone number of the subscriber" reads on col. 4, lines 33-37.

"receiving a value identification code associated with a prepaid local telephone service program" and "determining a period of service for the identified subscriber account" reads on col. 4, lines 42-55 where a dollar amount (value identification code) and a time (period of service) are determined

"monitoring the period of service at the prepaid local telephone call database" reads on col. 4, lines 55-59.

“sending termination date information to the subscriber prior to an expiration of the period of service” is a broad limitation and reads on col. 3, lines 40-60 where the system informs the subscriber that the subscriber’s budget has been exceeded “for the month” which implies the “current” month and therefore a series of unique dates that inherently comprise the “current” month. A series of dates can be said to be “date information”. Since the “date information” pertains to preventing all further calls from being charged to the prepaid service (col. 3, lines 58-60), the date information can be said to be “termination” date information with regard to the prepaid service. The termination date information is sent to the subscriber “prior” to terminating the service (expiration of the period of service).

Claim 8 differs substantively from claim 1 in that claim 8 recites a telephone network that performs the functions equivalent to the methods performed in claim 1. Therefore, see the claim 1 rejection for further details. “A prepaid local telephone call service center in communication with at least one local exchange carrier...” reads on Fig. 1, Call Expenditure Control Server (125) and LEC (52) which would be part of the local exchange carrier (local telephone company). “an application server having a processor and a subscriber database” reads on Fig. 1, Call Expenditure Control Server (125) and Control Processor (102) and col. 4, lines 35-45.

With respect to claim 14, the following limitations read upon Cohen.

"establishing a subscriber account on a prepaid local telephone service database, the subscriber account comprising subscriber identification information and a period of service" reads on col. 3, lines 13-21.

"monitoring the period of service for the subscriber account at the prepaid local telephone service database" reads on col. 4, lines 55-59.

"sending service termination information to the subscriber prior to an expiration of the period of service" reads on col. 4, lines 64-67.

Claim 16 substantively differs from claim 14 in the claim 16 recites that "a reminder message" is sent to the subscriber prior to expiration which reads on col. 4, lines 63-67 (or col. 3, lines 25-26). Claim 16 also recites sending a "suspend message" comprising "an instruction to suspend local telephone service for the subscriber" reads on the service "terminating" the prepaid service for the caller (col. 3, lines 29-40). The service can be restarted if the balance is replenished (col. 3, lines 35-36). Therefore, the service can be said to be temporarily "suspended". Since the caller is no longer use the prepaid calling service because the account is fully withdrawn, the account can be said to be "inactive" (no funds withdrawn for prepaid service for long distance calls).

With respect to claim 3, see col. 4, lines 63-67.

With respect to claims 4 and 10, the claim is worded broadly and reads on Fig. 5 where the service is implemented in a Local Exchange Carrier (local telephone company). The message comprising the "hold order" reads on a message inherently required by the LEC to prevent the subscriber from using the service after expiration (col. 3, lines 58-60). Since the service is restarted if the subscriber makes other arrangements for payment (col. 8, lines 35-40), the message can additionally be considered as placing the service on "hold" pending other payment arrangements. The message comprising the "hold order" also reads on the actual message sent to the subscriber inviting the subscriber to make other arrangements for the call (col. 8, lines 35-40).

With respect to claims 5 and 11, see col. 3, line 27.

With respect to claim 10, since Taskett discloses that the service may be continued upon an "other arrangements for payment" (col. 8, lines 35-40), the renewal invitation may be said to be a "hold order" pending arrangements for other payments.

With respect to claims 6 and 12, see col. 3, lines 29-31. Charging to the regular account during the grace period inherently requires "monitoring".

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With respect to claims 7 and 13, see col. 3, lines 31-38 where the grace period ends after the call is completed. On subsequent calls, calls to the prepaid service are blocked (cancel order) until the caller modifies the service. See Fig. 5 for implementation of the service at the Local Exchange Carrier (local telephone company) which receives a message to block the call.

With respect to claim 9, see col. 3, lines 29-32. See also Fig. 5 for implementation of the service at the Local Exchange Carrier (local telephone company).

With respect to claim 10, see the claim 16 rejection for further details.

With respect to claim 15, as it can best be understood, see the claim 1 rejection for further details.

With respect to claim 17, the "grace period" comprises the time required to start 37 (from when the suspend message is sent) and complete the announcement of col. 3, lines 34-40. The announcement is of a predetermined length. Therefore the grace period can be said to comprise a "predetermined length from when the suspend message is sent. Since the caller is blocked from the prepaid service upon subsequent calls after the suspend message, the caller can be said to be "disconnected" from the service after expiration of the grace period if the subscriber has not modified (renewed)

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the account subscriber. See also Fig. 5 for implementation of the service at the Local Exchange Carrier (local telephone company).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taskett in view of Jagadish et al. (U.S. Patent No. 5,844,972) [Hereinafter Jagadish].

With respect to claim 1, see the claim 15 rejection above for any additional details.

Taskett discloses that the user is prompted to enter information in order to identify the subscriber's account (col. 8, lines 8-18). However, Taskett fails to disclose

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that the subscriber's prepaid telephone calling card account is identified based on the "telephone number of the subscriber".

However, Jagadish teaches of a method where the subscriber's prepaid telephone calling card account is identified based on Automatic Number Identification (ANI) (telephone number of the subscriber) (abstract, col. 3, line 17 – col. 4, line 13).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the ability to identify a subscriber's prepaid telephone calling card account based on ANI (telephone number of the subscriber) as taught by Jagadish to the method that identifies the subscriber's prepaid telephone calling card account disclosed by Taskett.

The suggestion/motivation for doing so would have been to increase user-friendliness by not requiring the subscriber to enter identifying information but instead automatically identifying the subscriber by ANI. Additionally, the concept of identifying telephone service subscribers by ANI is notoriously well-known in the art.

With respect to claim 2, see Taskett, col. 8, lines 10-15.

With respect to claim 3, see Taskett, col. 8, lines 35-40.

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With respect to claim 4, see the claim 10 rejection for further details

With respect to claim 5, see the claim 9 rejection for further details.

With respect to claims 6 and 7, the grace period occurs during the renewal message (Taskett, col. 8, lines 38-40). The caller would be monitored for declining the invitation for other arrangements in order to continue the call. The "cancel order" would occur when the call is terminated.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen as applied to claim 1 above, and further in view of Taskett.

Although Cohen teaches the use of a voice response unit (col. 3, line 10), Cohen fails to disclose that voice recognition is used.

However, Taskett discloses of a similar telephone service system with expiration monitoring (Taskett anticipates many of the same claims as Cohen, see the rejections above) that uses voice recognition (col. 8, lines 10-15).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the voice recognition as taught by Taskett to the voice response unit disclosed by Taskett.

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The suggestion/motivation for doing so would have been to increase user-friendliness and flexibility by allowing the subscriber to enter information by speaking in addition to entering information on a telephone keypad. Additionally, the concept of a voice response unit that allows users to either speak or use a telephone keypad, such as "Press or speak 1 for savings" is notoriously well-known in the art.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen as applied to claim 16 above.

With respect to claim 18, "Official Notice" is taken that both the concept and advantages of providing free access to a prepaid service when the caller is attempting to make an emergency call are both well-known and expected in the art and would have been an obvious addition to Cohen in order to increase caller safety and to comply with regulations requiring free access in the case of emergency calls.

With respect to claim 19, see the claim 17 rejection for further details.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

<u>U.S. Patent No.</u>	<u>Date</u>	<u>Name</u>	<u>Title/Brief Description</u>
5,448,633	9/5/00	Jamaleddin et al.	TELECOMMUNICATIONS SYSTEM FOR CONTROLLING ACCESS TO A DESTINATION Prepaid telephone service with expiration monitoring.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone numbers for this group are (703) 308-6306 and (703) 308-6296.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

r.g.f.
January 2, 2001

